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EXAMINER

DURAN, ARTHUR D

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3622

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/695,590 | Applicant(s) GOLDMAN ET AL. | |
| | Examiner Arthur Duran | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34, 38-43, 48-67 and 85-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34, 38-43, 48-67 and 85-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3622

DETAILED ACTION

1. Claims 1-34, 38-43, 48-67, 85-104 have been examined.

Response to Amendment

2. The Amendment filed on 1/13/05 is sufficient to overcome the Sloane reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-34, 38-43, 48-67, 85-104 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sloane et al., 6,434,530 (Aug. 13, 2002) [US f/d: 1/20/1999] (herein referred to as "Sloane") in view of Barnett (6,321,208) in view of Campbell (6,490,458).

As per claim 1, Sloane (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1067; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59) shows the marketing method of claim 1.

Sloane lacks an explicit recital of claim 1 even though Sloane reasonably suggests same. It would have been obvious to one of ordinary skill in the art at the time of the invention that Sloane (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; col. 1, ll. 12-67;

Art Unit: 3622

col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1067; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59) would have been selected in accordance with claim 1 because claim 1 suffers from undue breadth and because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

As per dependent claims 2-12, Sloane shows the method of claim 1 and subsequent base claims depending from claim 1.

Sloane lacks explicit recitation of the elements and limitations of claims 2-12, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-12 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-12, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Art Unit: 3622

Independent claim 13 is rejected for substantially the same reasons as independent claim

1.

As per dependent claims 14-24, Sloane shows the system of claim 13 and subsequent base claims depending from claim 13.

Sloane lacks explicit recitation of the elements and limitations of claims 14-24, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 14-24 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 14-24, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Independent claim 25 is rejected for substantially the same reasons as independent claim

1.

Art Unit: 3622

As per dependent claims 26-29, Sloane shows the method of claim 25 and subsequent base claims depending from claim 25.

Sloane lacks explicit recitation of the elements and limitations of claims 26-29, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 26-29 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 26-29, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Independent claim 30 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 31-34, Sloane shows the system of claim 30 and subsequent base claims depending from claim 30.

Sloane lacks explicit recitation of the elements and limitations of claims 31-34, even though the disclosure of Sloane reasonably suggests same.

Art Unit: 3622

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 31-34 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 31-34, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Independent claim 35 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 36-37, Sloane shows the method of claim 35.

Sloane lacks explicit recitation of the elements and limitations of claims 36-37, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 36-37 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 36-37, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable*

Art Unit: 3622

manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made. " (See Sloane (col. 2, ll. 40-60).

Independent claim 38 is rejected for substantially the same reasons as independent claim

1.

As per dependent claims 39-40, Sloane shows the system of claim 38.

Sloane lacks explicit recitation of the elements and limitations of claims 39-40, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 39-40 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 39-40, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made. " (See Sloane (col. 2, ll. 40-60).*

Independent claim 41 is rejected for substantially the same reasons as independent claim

1.

As per dependent claims 42-43, Sloane shows the method of claim 41.

Art Unit: 3622

Sloane lacks explicit recitation of the elements and limitations of claims 42-43, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 42-43 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 42-43, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Independent claim 44 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 45-46, Sloane shows the system of claim 44.

Sloane lacks explicit recitation of the elements and limitations of claims 45-46, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 45-46 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 45-46, because selection of such

Art Unit: 3622

features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Independent claim 47 is rejected for substantially the same reasons as independent claim 1.

As per independent claim 48, Sloane (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1067; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59) reasonably suggests the elements and limitations of claim 48; however,

Sloane lacks explicit recitation of the elements and limitations of claim 48, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claim 48 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 48, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable*

Art Unit: 3622

manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made. " (See Sloane (col. 2, ll. 40-60).

As per dependent claims 49-57, Sloane shows the method of claim 48 and subsequent base claims depending from claim 48.

Sloane lacks explicit recitation of the elements and limitations of claims 45-46, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 45-46 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 45-46, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made. " (See Sloane (col. 2, ll. 40-60).*

Independent claim 58 is rejected for substantially the same reasons as independent claim 48.

Art Unit: 3622

As per dependent claims 59-67, Sloane shows the system of claim 58 and subsequent base claims depending from claim 58.

Sloane lacks explicit recitation of the elements and limitations of claims 59-67, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 59-67 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 59-67, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Independent claim 68 is rejected for substantially the same reasons as independent claim 1.

Independent claim 69 is rejected for substantially the same reasons as independent claim 1.

As per independent claim 70, Sloane (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-

Art Unit: 3622

67; col. 8, ll. 1067; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59) reasonably suggests the elements and limitations of claim 70; however,

Sloane lacks explicit recitation of the elements and limitations of claim 70, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claim 70 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 70, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

As per dependent claims 71-72, Sloane shows the method of claim 70.

Sloane lacks explicit recitation of the elements and limitations of claims 71-72, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 71-72 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of

Art Unit: 3622

the invention to include the elements and limitations of claims 71-72, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Independent claim 73 is rejected for substantially the same reasons as independent claim 1.

As per dependent claim 74, Sloane shows the method of claim 73.

Sloane lacks explicit recitation of the elements and limitations of claim 74, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims claim 74 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 74, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Art Unit: 3622

Independent claim 75 is rejected for substantially the same reasons as independent claim

1.

As per dependent claims 76-79, Sloane shows the method of claim 75 and subsequent base claims depending from claim 75.

Sloane lacks explicit recitation of the elements and limitations of claims 76-79, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 76-79 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 76-79, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Independent claim 80 is rejected for substantially the same reasons as independent claim 75.

As per dependent claims 81-84, Sloane shows the system of claim 80 and subsequent base claims depending from claim 80.

Art Unit: 3622

Sloane lacks explicit recitation of the elements and limitations of claims 81-84, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 81-84 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 81-84, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Independent claim 85 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 86-94, Sloane shows the system of claim 85.

Sloane lacks explicit recitation of the elements and limitations of claims 86-94, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 86-94 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of

Art Unit: 3622

the invention to include the elements and limitations of claims 86-94, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Independent claim 95 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 96-104, Sloane shows the system of claim 95.

Sloane lacks explicit recitation of the elements and limitations of claims 96-104, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 96-104 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 96-104, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

Art Unit: 3622

As per independent claim 105, Sloane (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1067; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59) reasonably suggests the elements and limitations of claim 105; however,

Sloane lacks explicit recitation of the elements and limitations of claim 105, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claim 105 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 105, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

As per dependent claim 106, Sloane shows the system of claim 105.

Sloane lacks explicit recitation of the elements and limitations of claim 106, even though the disclosure of Sloane reasonably suggests same.

Art Unit: 3622

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims claim 106 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 106, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll. 40-60).

As per independent claim 107, Sloane (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1067; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59) reasonably suggests the elements and limitations of claim 107; however,

Sloane lacks explicit recitation of the elements and limitations of claim 107, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claim 107 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 107, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make*

Art Unit: 3622

intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made. " (See Sloane (col. 2, ll. 40-60).

As per dependent claim 108, Sloane shows the system of claim 107.

Sloane lacks explicit recitation of the elements and limitations of claim 108, even though the disclosure of Sloane reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims claim 108 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 108, because selection of such features would have provided *"shoppers with the kind of supplemental information required to make intelligent shopping decisions at the times such decisions are being made and enable manufacturers to influence shopping decisions, for example with price and/or product advisories, at the time the decisions are being made."* (See Sloane (col. 2, ll 40-60).

Additionally, Sloane discloses wireless device and bar code scanning:

"(23) The apparatus can further comprise a bar code scanner. The apparatus can be adapted for selectively mounting on a shopping cart and for being carried by the shopper (col 3, lines 49-52);

Art Unit: 3622

(24) The system can further comprise a plurality of the mobile interactive apparatus adapted for storage in a rack, the apparatus being adapted for the mobile use upon selective removal from the rack (col 3, lines 52-56);

(25) The system can further comprise a rack for storing a plurality of the mobile interactive apparatus, each apparatus being adapted for the mobile use upon selective removal from the rack (col 3, lines 55-60);

(8) The base station 40 is provided with a wireless transceiver 408 having an antenna 410. The base station can communicate with the wireless transceiver 408 through a communications link 18. The wireless transceiver 408 can communicate with a help desk station 80 through a communications link 82. Different frequencies can be used to communicate with respective apparatus 10, or other multiplexing data transmission schemes can be employed (col 6, lines 20-37);

(20) The base station communicates with each apparatus 20 by a wireless communications link 18" (col 9, lines 30-35).

Sloane discloses targeting a user including targeting a particular user and also profiling a user:

"(3) The invention relates generally to the fields of shopping and advertising, and in particular, to an interactive shopping system which can provide shoppers with useful product information for assisting the shopper at the time and place of article selection, and which can also provide promotions and discounts from a marketing and advertising campaign targeted for influencing the shoppers' choices at the time and place of article selection (col 1, lines 11-20).

Art Unit: 3622

(19) In a commercial sense, the interactive shopping system 10 can be exploited for marketing purposes and efforts to direct shopper's habits and selections with respect to articles selected for purchase. Marketing efforts can be directed not only to specific shopping venues but to specific classes of shoppers at each shopping venue, because each shopper is provided with his or her own apparatus 20 while shopping. Indeed, it would be possible to target specific shoppers (col 9, lines 15-25);

(10) With respect to cost, a recipe can even be selected on the basis of the maximum cost savings of ingredients, with regard to ingredients on sale or associated with coupons. As a specific example, a shopper can request a recipe, filled by the least expensive ingredients available, for an Italian style meal including eggplant, pasta, low fat tomato sauce and fat free cheese. In this case, the requirements for low fat tomato sauce and fat free cheese can eliminate from consideration tomato sauces and cheeses which are less expensive but do not satisfy the low fat and fat free criteria. Additional ingredients which might be necessary for the recipe, for example bread crumbs, can be included in the suggested shopping list, even if those ingredients were not specified in the query. Whether or not a recommended brand of bread crumbs would be based on cost or on fat content, or both, for example, can depend upon the shopper's personal profile if no pertinent criteria are included in the query. If sufficient criteria are not available in the personal profile or in the query, the AIU 406 can make the selection based on default rules, for example, based on the shopper's choices of articles already selected during shopping. A similar procedure would be undertaken, for example, if eggs or egg substitutes were required. Moreover, the AIU 406 has access to the list of articles selected by the shopper and can determine if any of the ingredients have already been placed in the shopper's

Art Unit: 3622

cart. Default procedures can be utilized in the absence of information in the shopper's personal profile. A neural network is especially adapted for such kinds of processing, and in the presently preferred embodiment, AIU 406 is a neural network" (col 7, lines 25-55).

Sloane discloses presenting specialized information when items are scanned and also that items a user scans is recorded and the long term history of items purchased is tracked:

"(27) The artificial intelligence unit can generate, for example, one or more of the following: a shopping list responsive to an audible customer query; warnings when values of data in the information supplied to the shopper for shopper-selected articles is out of a predetermined range; price and/or price advisories based on shopper-selected articles; and, a tutorial running concurrently and intermittently with selection of the articles. Parts of the tutorial can be initiated by scanning the articles (col 4, lines 5-15);

(21) These buttons can be used, for example, in conjunction with a bar code scanner 218 to update and revise the electronic list of articles selected and scanned for purchase as such articles are placed into the shopper's shopping cart. The bar code scanner can be activated by buttons 220 and 222. Buttons 212, 214 and 216 are generically labeled for three functions F1, F2 and F3 respectively (col 9, lines 55-65);

(24) In the environment of a shopping venue for an automobile dealership, the mobile apparatus can enable shoppers to roam through a lot, and be supplied with information regarding cars which are scanned while roaming (col 10, lines 28-33);

(38) FIG. 2 illustrates a few of the responses that a shopper can receive. If an 8 ounce (oz.) size of a product is scanned, for example, the shopping system can alert the shopper that a larger size is on sale, as in message 250. If a shopper has entered into a personal profile a

Art Unit: 3622

preference for reduced fat foods, and if a tomato sauce is scanned having a certain fat content, the system can alert the shopper that a comparable brand is available with less fat, as in message 252. The shopper then has an opportunity to replace the first article with the second article, using the scanner control buttons to delete the first article. The shopper can also invoke one of the functions, such as Show Me, as shown in message 254. The shopper is then presented with a list of descriptions of available Show Me functions, for example, best price 256, least salt 258, name brand 260, store brand 262 and new product 272. The list can include button icons, shown as dots, to reinforce the need to press the screen to select the function (col 13, lines 15-34);

(44) As the shopper is moving through the shopping venue and browsing products, the shopper can use the scanner to read the Universal Product Code (UPC) bar codes of products they are interested in, or can scan shelf labels having the product UPC bar code, and request information on these or similar or associated products (col 14, lines 27-34);

(23) In the environment of a shopping venue for video rentals, the screen can be used to enable shoppers to view movie trailers prior to rental. In this example, the movie trailers represent the data in the supplemental data base. From the marketing side, the exhibition of movie trailers can also be automatic and based on the shopper's rental history and user profile. A shopper might request, for example, that trailers for all new releases, or all new science fiction releases, be displayed every time the shopper checks out a mobile apparatus. In such a shopping venue, the bar code scanner can be used as the movie and movie trailer selection tool, as the shopper moves up and down the aisles" (col 10, lines 8-20).

Art Unit: 3622

Sloane discloses specialized actions depending on particular or qualified shoppers and also tracking what items are scanned for inspection by a user:

“(30) In certain kinds of shopping venues, the mobile apparatus can also be provided with a device, not shown in FIG. 2, for deactivating electronic article surveillance security tags. While this might seem to entail some risk, such a function can be useful under certain circumstances. In accordance with an inventive arrangement, certain articles can be provided with two levels or stages of security, for example represented by two security tags. A first level would monitor exits from the shopping venue to prevent an article from being stolen, whereas a second level can enable articles to be removed from a special display area for closer inspection within the shopping venue. With regard to security concerns, this function can be reserved for only qualifying shoppers and the deactivation can be transmitted to the interactive system so that the retailer is advised that a particular article has been selected for inspection by a particular shopper” (col 11, lines 25-41).

The Amendment dated 1/13/05 recognizes that “Sloane discloses printing of product coupons”. Sloane does not explicitly disclose dynamically changing a characteristic of the product coupon as recited in claims 1 and 13 or to dynamically change an amount of a product coupon as recited in claims 85 and 95.

However, Barnett discloses changing the value of a coupon offered to a user based on known information concerning that user (col 13, lines 24-45) and targeting a user with certain coupons based on known information about that user (col 12, lines 37-65) and that coupons can

Art Unit: 3622

be utilized for product/items that have scannable UPC numbers (Fig. 5, item 82 'item's UPC number).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's dynamic coupons to targeted users to Sloane's presenting coupons to targeted users. One would have been motivated to do this in order to increase the likelihood that a user will be interested in or utilize a coupon for product purchase.

Sloane discloses maintaining a customer account database or displaying the account data on a customer's scanning terminal as recited in claim 41. Sloane discloses customer information with various account attributes, correlated to at least one of present customer coupons, future customers coupons, and present customer scanning points.

Sloane discloses a customer account database or displaying the account data on a customer's scanning terminal as recited in claim or displaying the point balance of account and also displaying information on discounts or coupons:

“(42) Examples of information which can be requested by shoppers include: the point balance in the shopper's frequent shopper account; the store aisle location of a specific product; a meal plan that provides information, such as a low-calorie dinner; a replenishment reminder of frequently purchased products which have not been purchased recently; and, the amount of money the shopper has saved this week, this month or year-to-date, using the system (col 14, lines 10-19);

(39) One such marketing initiative is to display for the shopper a list of all articles displayed along the aisle which are marked down as specials or for which cents-off coupons are

Art Unit: 3622

available. An audible message can be presented to the shopper which alerts the shopper to observe the screen for a list of all such articles and the price reduction” (col 13, lines 45-60).

Sloane discloses awarding a user with discounts for items that have been scanned and then purchased:

“(54) The interactive voice response feature of the system also enables the shopper to use speech to produce desired results. For example, when the shopper is informed that the manufacturer is offering a 50 cents (\$ 0.50) off electronic coupon for a scanned item, the system can ask the shopper to say "Yes" to accept the discount, and would then add the item to the purchase total at the lower price. In another example, when the shopper is informed there is a \$2.00 refund offer on purchasing two of a product, the system will ask the shopper to say "Yes" to accept the offer, and the required mail-in form can be printed out at the storage rack when the mobile apparatus is checked in” (col 15, lines 45-56).

In Applicant’s Amendment dated 1/13/05, Applicant states, “Sloane does not teach or suggest the use of a point system to reward a customer for use of the scanning system. In contrast, claims 25 and 30 recite a method and system, respectively, for marketing which includes assigning scanning points to a customer in response to at least the reading of a bar code by the customer with one of the wireless bar code reading terminals and adding the scanning points to the scanning point account of the customer”.

However, Sloane discloses that customers are rewarded with points for desirable behaviors (frequent shopper point totals) and that it is desirable for customers to scan items for

Art Unit: 3622

the purpose of tracking what items the user has scanned and that the items that a user scans are tracked and that customers are rewarded for purchasing items after items have been scanned.

Therefore, it would be obvious that Sloane can reward users for scanning items. Sloane would be motivated to do this to encourage users to scan items.

Sloane does not explicitly disclose a locking method or system, as recited in claims 48 and 58, that prevents a terminal from being removed from a terminal station if its battery is not charged.

However, Campbell discloses preventing a portable, wireless communication device from being removed from a station if the battery is not charged on the device:

“(31) The phone unit 330 determines whether the battery 790 in the handset 610 contains a sufficient charge [step 1110]. The phone unit 330 might do this by simply comparing the remaining charge in the battery 790 against a predetermined threshold. The threshold might be set to a level that supports a certain time period for a telephone call. If the battery 790 contains an insufficient remaining charge, the phone unit 330 prevents removal of the handset 610 through operation of the locking mechanism 370 [step 1115] (FIG. 11B). The card reader 350 then notifies the caller that the phone unit 330 is temporarily out of order and returns the caller's card [step 1120]. The card reader 350 may notify the caller by displaying an "OUT OF ORDER-PHONE CHARGING" message on display 360. Of course, steps 1110-1120 may occur prior to step 1105” (col 6, lines 37-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Campbell's preventing the taking of uncharged portable units to

Art Unit: 3622

Sloane's providing useable, portable units. One would have been motivated to do this in order to provide users units that can be properly utilized.

Response to Arguments

4. Applicant's arguments with respect to claims 1-34, 38-43, 48-67, 85-104 have been considered but are moot in view of the new ground(s) of rejection.

Please note the additional citations, explanations, and references added at the section above starting with, "Additionally, Sloane discloses wireless device and bar code scanning...".

On page 21 of the Applicant's Amendment dated 1/13/05, Applicant states:

"Although Sloane discloses printing of product coupons, there is no teaching or suggestion in Sloane to dynamically change a characteristic of the product coupon as recited in claims 1 and 13 or to dynamically change an amount of a product coupon as recited in claims 85 and 95. . .

Sloane does not teach or suggest the use of a point system to reward a customer for use of the scanning system. In contrast, claims 25 and 30 recite a method and system, respectively, for marketing which includes assigning scanning points to a customer in response to at least the reading of a bar code by the customer with one of the wireless bar code reading terminals and adding the scanning points to the scanning point account of the customer".

On Page 23 Applicant states:

"Sloane does not teach or suggest maintaining a customer account database or displaying the account data on a customer's scanning terminal as recited in claim 41. . .

customer information with various account attributes, correlated to at least one of present

Art Unit: 3622

customer coupons, future customers coupons, and present customer scanning points".

On page 24, Applicant states:

"Sloane contains no teaching or suggestion to include a locking method or system, as recited in claims 48 and 58, that prevents a terminal from being removed from a terminal station if its battery is not charged".

These concerns are addressed above.

Also, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Sloane (5,918,211) discloses scanning and rewards:

Art Unit: 3622

“(19) In another embodiment of the invention, the consumer will retrieve the portable bar code scanner from the scanner center, and in doing so, or immediately thereafter, scan their frequent shopper card bar code in order to identify them to the retailer's computer/controller. This will facilitate the consumer taking advantage of any discounts, credits, reward or product promotions contained and stored in their electronic frequent shopper account. Through the portable bar code scanner, the consumer can be alerted as to the available discounts, credits, rewards or promotions. In the alternative, the portable bar code scanner can alert the consumer as to the presence of the electronic discounts, credits, rewards or promotion in their frequent shopper account when the consumer scans the actual product that is the subject of that promotion”;

b) Von Kohorn (5,227,874) discloses identifying users as price sensitive and/or presenting targeted and/or dynamically adjustable coupons to users.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Arthur Duran', is positioned above the printed name.

Arthur Duran
Patent Examiner
5/18/05